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09/360,419	07/23/1999	AMIR DORON	HP10991005-1	4168

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EXAMINER

GENCO, BRIAN C

ART UNIT PAPER NUMBER

2615

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Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/360,419
Filing Date: July 23, 1999
Appellant(s): DORON, AMIR

MAILED

JUN 03 2005

Technology Center 2600

Michael H. Jester
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed April 6, 2005.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Grounds of Rejection*

The appellant's statement of the grounds of rejection at the time of filing the brief was correct, however, new grounds of rejection are presented in accordance with 37 CFR 41.39(b).

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(9) Prior Art of Record

5,440,343	Parulski et al.	8-1995
6,148,031	Kato	11-2000

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 11-19 and 21-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over (USPN 5,440,343 to Parulski et al.) in view of (USPN 6,148,031 to Kato).

In regards to claim 11 Parulski discloses a method of generating images with a digital camera, comprising the steps of:

selectively generating a first sequence of high resolution still images (e.g., column 1, lines 55-64; column 2, lines 3-9) or a second sequence of low resolution still images (e.g., column 1, lines 55-64; column 2, lines 3-9; element 20 of Fig. 1; wherein the motion scene disclosed by Parulski is a series of still images captured at a rate of 30 still images/second) and storing the images in the memory (e.g., element 16 of Fig. 1).

Parulski does not disclose selectively retrieving the second sequence of still image files from the memory and converting the second sequence of still image files to a motion video sequence in accordance with a predetermined motion image data compression standard, the conversion being performed with firmware and storing the motion video sequence.

Kato discloses to utilize compression such as JPEG for still images and MPEG for motion images so as to reduce the quantity of recorded data (e.g., column 1, lines 24-29). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to utilize compression such as JPEG for still images and MPEG for motion images before recording Parulski's images so as to reduce the quantity of recorded data. As such, the first sequence of still images are stored in accordance with a predetermined still image data compression standard, JPEG.

Further, Kato discloses that in still image picture taking some degree of post processing is tolerable since the quality of the image is a priority. However, with motion picture taking the frame rate is dependent on the time required for post processing and therefore the time required for compression must be shortened (e.g., column 1, lines 42-51). In order to overcome this problem Kato discloses that when capturing motion picture sequences to quickly compress and store the series of images as JPEG images, i.e., intra-frame encoding (e.g., column 3, lines 42-47;

column 8, lines 55-57). This series of JPEG still images is then re-compressed via inter-frame encoding, i.e., MPEG, by software in the system control circuit 26, i.e., firmware, since the re-compression is less time sensitive (e.g., column 3, lines 54-63; column 7, lines 52-56).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to quickly compress the series of images in the motion picture sequence generated by Parulski using JPEG compression in order to reduce the initial post processing of images in a motion picture sequence and subsequently re-compress the series of JPEG images with MPEG compression by using firmware since the re-compression is less time sensitive.

In regards to claim 12 note that JPEG compression was used as the predetermined still image data compression standard as indicated in the rejection of claim 1.

In regards to claim 13 note that MPEG compression was used as the predetermined motion image data compression standard as indicated in the rejection of claim 1.

In regards to claim 14 Kato teaches the use of JPEG compression (col. 3, lines 54-61) through the use of compression/decompression circuit 18 seen in Fig. 1.

In regards to claims 16 and 17 Parulski discloses capturing the motion images at 30 frames/second (e.g., column 1, lines 60-62). Kato also discloses capturing the motion images at the standard 30 frames/sec (column 1, lines 52-55; column 4, lines 11-25).

In regards to claim 18, Parulski teaches the generation of a first sequence of high resolution still image files in response to each momentary actuation of the trigger switch, and the generation of a second sequence of low resolution still image files in response to the trigger switch being actuated and held for a predetermined duration longer than the momentary actuation (col. 3, lines 16-32).

In regards to claim 21 see Examiners notes on the rejection of claim 11. Note that Parulski discloses an image sensor element 12 of Fig. 1, a shutter button element 22 of Fig. 1, and a circuit for processing the output signals element 15 of Fig. 1.

In regards to claims 22 and 23 see Examiner's notes on the rejections above.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over (USPN 5,440,343 to Parulski et al.) in view of (USPN 6,148,031 to Kato) in view of ("Digital Still Camera Image File Format Standard (Exchangeable image file format for Digital Still Cameras: Exif) Version 2.1"; JEIDA; June 12, 1998), herein Exif 2.1.

Regarding claim 15, Kato in view of Parulski does not disclose nor preclude embedding of JPEG files in corresponding EXIF files. Exif 2.1 discloses to utilize the EXIF file format so as to store metadata concerning photographing conditions and settings at the time of photography for use in later processing (e.g., Revision History, page 2). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have embedded the JPEG files in the EXIF file format so as to store metadata concerning photographing conditions and settings at the time of photography for use in later processing.

Claims 19 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over (USPN 5,440,343 to Parulski et al.) in view of (USPN 6,148,031 to Kato) in view of (USPN 6,226,449 to Inoue et al.).

In regards to claim 19 Parulski does not disclose to selectively display selected ones of the high resolution still images or the motion video sequence. Inoue discloses a camera which

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can capture still images or motion images and further discloses a display screen for selectively displaying a movie or still image captured by the camera via a list which enables a comfortable operability to quickly select a recorded image (e.g., column 7, line 49 – column 8, line 22; column 6, lines 7-14). Therefore it would have been obvious to one of ordinary skill in the art to have added a display to Parulski's invention in order to enable playback of the recorded images or video sequences. Further, it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized Inoue's listing of recorded images so as to enable selectively displaying a movie or still image with comfortable operability to quickly select a recorded image.

In regards to claim 24 see Examiner's notes on the rejection of claims 19 and 21.

Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over (USPN 5,440,343 to Parulski et al.) in view of (USPN 6,148,031 to Kato) in view of (USPN 6,771,896 to Tamura et al.)

In regards to claim 25 neither Parulski nor Kato disclose nor preclude a control circuit for causing a markup file to be generated in response to user commands. Examiner notes that it is well known in the art to generate print orders from a camera as disclosed by Tamura so as to enable printing from a camera (column 8, lines 48-54; column 9, line 56 – column 10, line 16; column 10, lines 51-57). Examiner notes that Tamura discloses this enables a user to prepare order information in advance such that the time required by the order in the photofinisher can be reduced and the order can be made to an unmanned counter. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have enabled Parulski in

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view of Kato to generate a print order, or markup file, in order to enable printing from a camera by letting a user to prepare order information in advance such that the time required by the order in the photofinisher can be reduced and the order can be made to an unmanned counter.

(11) *Response to Argument*

As a new grounds of rejection have been made as noted above only the arguments pertinent to the new grounds of rejection will be answered herein below.

Appellant argues that there is no suggestion in either Kato or Parulski to combine the references.

In response, Examiner notes that there is express motivation found in Kato that when recording a motion video sequence to first quickly compress the sequence of images using JPEG and to later re-compress the images in MPEG using firmware when there are less time constraints.

Appellant argues that Parulski is no more pertinent to the claimed invention than the prior art illustrated in Figs. 3 and 4.

In response, Examiner notes that Parulski is not at all like the prior art Figs. 3 and 4. In particular, Parulski is mostly interested in the resolution of the output of the CCD, namely generating high resolution still images in a still image capture mode and low resolution motion images in a motion image capture mode, and the CCD architecture need to accomplish that.

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Parulski does not even disclose to perform JPEG or MPEG compression encoding on the images. As such, it is unclear what parallel hardware architecture Appellant is referring to.

Appellant argues that there is no reasonable expectation of success when combining Parulski and Kato.

In response, Examiner notes that Parulski discloses generating different resolution images in motion and still image capture modes and recording the images captured. Parulski does not disclose any compression techniques. Kato discloses to utilize compression to save storage space as is extremely well known in the art. Further, Kato discloses that when recording a motion video sequence to first quickly compress the sequence of images using JPEG and to later re-compress the images in MPEG using firmware when there are less time constraints. As such, since the teachings of the two references are for two different aspects of the generation and recording of the image it is clear that there would be a reasonable expectation of success. In particular, there is nothing about the way that Kato compresses the images that would effect the output of the CCD of Parulski.

Appellant argues that Kato does not disclose to use firmware to convert low resolution image files into a video sequence.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Examiner notes that Parulski was

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relied upon to teach the generation of low resolution images in a video sequence. Kato was relied upon to teach converting the low resolution images generated by Parulski into an MPEG file using firmware as discussed above, wherein the software in the system control of Kato is firmware. As such, the combination of references as a whole teaches the claim limitations.

For the above reasons, it is believed that the rejections should be sustained.

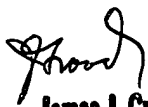
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Respectfully submitted,


Brian Genco
May 24, 2005

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